UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,616	10/13/2000	RICHARD E. MCNUTT	ODS-26	9821

1473   7590   07/30/2003
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

EXAMINER
COBURN, CORBETT B

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicatio n N .	Applicant(s)
	09/687,616	MCNUTT ET AL.
	Examin r	Art Unit
	Corbett B. Coburn	3714

-- The MAILING DATE of this communication app ars on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 May 2003</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32,36-73 and 77-158</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>28,69,120 and 158</u> is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on <u>06 May 2003</u> is: a)☐ approved b)☒ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

DETAILED ACTION

Drawings

1.   The drawings are objected to because the drawings do not reflect the claim

language. The amended drawings still refer to "totes" where the claims refer to

"wagering pools". A proposed drawing correction or corrected drawings are required in

reply to the Office action to avoid abandonment of the application. The objection to the

drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2.   The rejections under 35 USC §112 have been overcome by Applicant's

amendment and are hereby withdrawn.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-4, 6, 8-12, 14-18, 20-22, 30-32, 36, 39-45, 47, 49-53, 55-59, 61-63, 71-

73, 77, 80-86, 88, 90-94, 96-100, 102-104, 111-114, 117-119, 121-124, 126, 128-132,

134-138, 140-142, 149-152 & 155-157 are rejected under 35 U.S.C. 102(b) as anticipated

by Brenner et al. (US Patent Number 5,830,068).

     Claims 1, 42, 83 & 121: Brenner describes a method for allowing a user to use

user equipment to place an electronic wager on a race with an interactive

wagering application. (Abstract & Fig 1) The interactive wagering application

provides the user the opportunity to create a wager of a particular wager type on a particular race. (Col 7, 21-24) The user may, for instance, place a wager for a particular horse to win, place, or show in a particular race. (Fig 14) This provides access to multiple independent wagering pools wherein each wagering pool is capable of accepting the wager of the particular wager type for the particular race. In pari-mutuel race betting, the win, place, and show pools are mutually independent and are each capable of accepting bets. The interactive wagering application is used to place a wager with one of the multiple wagering pools.

Claims 2, 43, 84 & 122: Brenner teaches automatically applying wagering pool selection criteria using the interactive wagering application. When a player places a bet on a horse to win, the system automatically selects the correct wagering pool – i.e., the win pool. Furthermore, Brenner teaches automatically applying selection criteria so that certain users are "permitted to have access to certain racetracks, sets of races, wager types, or wager amounts," in order to "provide various tiers of service." (Col 10, 56-61) By automatically applying selection criteria, Brenner automatically determines which wagering pool is selected based on certain criteria.

Claims 3, 6, 44, 47, 85, 88, 123 & 126: Brenner teaches using the interactive wagering application to place the wager with one of the multiple wagering pools by providing the user with an opportunity to manually apply wagering pool selection criteria. Fig 14 shows manual input buttons for selecting the win, place, show, etc., pools.

Claims 4, 45, 86 & 124: The race is a horse race and the wager is a wager on a

horse race. (Col 1, 13)

Claims 8, 49, 90 & 128: Brenner teaches a display screen that allows the user to

choose a pool by name. (Fig 14) The player may choose the win pool, the place

pool, the show pool, etc., by name.

Claims 9, 50, 91 & 129: Fig 14 shows a display screen with a list of available

totes for wagering along with odds information associated with the pool.

Claims 10, 11, 51, 52, 92, 93, 130 & 131: Brenner teaches a display screen with

a list of available pools for wagering (Fig 14) and a display of average odds

information associated with the pool.

Claims 12, 53, 94 & 132: Fig 9 discloses displaying a screen that allows the user

to select a racetrack for the wager using a highlight region. In this case, Pimlico

is highlighted.

Claims 14-16, 55-57, 96-98 & 134-136: Figs 12-17 shows a display screen that

contains a list of wagers and information on the current odds available at the

wagering pool chosen by the user for each of the wagers. The Send Wager box is

an option that allows the user to submit the wager for processing by a given pool.

Claims 17, 58, 99 & 137: Brenner's Figs 12-17 teaches allowing the user to use

the interactive wagering application to select the given one of the multiple

wagering pools; displaying a screen for the user that contains a list of wagers and

information on the current odds available at the given pool for each of the wagers;

and displaying an option on the screen that allows the user to select another pool

for the wager (i.e., place additional bets).

Claims 18, 59, 100 & 138: Fig 18 shows a screen that contains a grid arrangement with information about each of the multiple wagering pools.

Claims 20, 61, 102 & 140: Fig 19 shows a screen containing the name of the pool and the pool value. (274)

Claims 21, 62, 103 & 141: Fig 14 shows a screen with information on the name of pool (i.e., win, place, show, etc.) and odds information for the wager that is associated with the pool.

Claims 22, 63, 104 & 142: Fig 18 is a screen that displays information on the name of the pool, the odds associated with the wager, and the pool value for the pool.

Claims 30, 71, 111 & 149: Brenner teaches automatically applying selection criteria so that certain users are "permitted to have access to certain racetracks (and their associated totes), sets of races, wager types (i.e., wagering pools), or wager amounts." (Col 10, 56-61)

Claims 31, 72, 112 & 150: Account information is displayed for each of the multiple wagering pools. (Abstract)

Claims 32, 73, 113 & 151: The account information includes account balance for each of the wagering pools. (Col 15, 46-49)

Claims 36, 77, 114 & 152: Brenner teaches that the use of telephones to effectuate off-track wagering is well known to the art. (Col 1, 26-35) Cellular telephones are inherently within the class of telephones.

Claims 39, 80, 117 & 155: The user equipment includes user television equipment that may be used to create a wager. (Col 8, 13-14)

Claims 40, 81, 118 & 156: The user equipment is a set-top box that allows the

user to create a wager. (Col 7, 55-Col 8, 15)

Claims 41, 82, 119 & 157: Brenner teaches sending the wager to a transaction

processing and subscription management system over a communications path

connected to the user equipment. (Col 2, 30-35)

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 5, 7, 29, 46, 48, 70, 87, 89, 110, 125, 125 & 148 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brenner as applied to claim 1, 42, 83 or 121

above, and further in view of Walker et al. (US Patent Number 6,001,016).

Claims 5, 7, 29, 46, 48, 70, 87, 89, 110, 125, 125 & 148: Brenner teaches the

invention substantially as claimed. While Brenner teaches the use of menus,

Brenner does not explicitly teach a setup option menu wherein the user may

access tote selection features (user preferences) of the interactive game. Walker,

an analogous invention, teaches a setup menu in which the player is prompted to

enter slot machine selection parameters. This allows the system to automatically

tailor the gaming environment to suit the player's requirements. It would have

been obvious to one of ordinary skill in the art at the time of the invention to

modify Brenner's system in view of Walker to have a setup option menu wherein

the user may access wagering pool selection features of the interactive game to

enter user preferences so that the system can automatically tailor the gaming

environment to suit the player's requirements.

7.   Claims 13, 37, 38, 54, 78, 79, 95, 115, 116, 133, 153 & 154 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brenner as applied to Claim 1, 42, 83 or 121 as

appropriate.

Claims 13, 54, 95 & 133: Brenner teaches the invention substantially as claimed.

Brenner teaches allowing the user to create a plurality of wagers. (Col 12, 9-11)

Brenner teaches a display screen that displays the odds for each wager in the

queue. (Fig 16) Brenner does not, however, teach display of weighted odds

information based on each of the plurality of bets for each of the available totes.

Brenner teaches that one of the advantages of the system described is that the user

can control the display of the odds and payoff screens for various wager types.

(Col 14, 4-6) The system described in Brenner has the ability to display

"information regarding exacta, trifecta, and other complex wager pool totals and

payoff values for the various wager combinations selected." (Col 13, 39-41)

Providing the weighted odds information for each available tote would be well

within the capability of Brenner's invention. Brenner teaches the value of

providing detailed information to the user in order to allow the user to make a

fully informed betting decision. (Col 2, 8-12) It would have been obvious to one

of ordinary skill in the art at the time of the invention to have displayed weighted

odds information based on each of the plurality of bets for each of the available

totes in order to provide detailed information to the user thus allowing the user to

make a fully informed betting decision.

Claims 37, 38, 78, 79, 115, 116, 153 & 154: The user terminal (122) is a computer. While Brenner does not specifically teach that the user terminal (122) can be a handheld computer or a personal computer, these devices are functionally equivalent to the user terminal described. Both personal computers and handheld computers are well known and there is a huge number of potential users who already own such equipment. Implementing Brenner's invention on a handheld or personal computer would allow a user to use the invention without buying additional hardware. This would reduce costs to the user. It would have been obvious to one of ordinary skill in the art at the time of the invention to have implemented the disclosure of Brenner on a handheld or personal computer in order to take advantage of the huge number of huge number of potential users who already own such equipment, thus allowing them to reduce costs by using the system without buying additional hardware.

8. Claims 19, 23-27, 60, 64-68, 101, 105-109, 139 & 143-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner as applied to claim 1, 42, 83 or 121 above, and further in view of Hirsimaki (US Patent Number 4,001,551).

Claims 19, 60, 101 & 139: Brenner teaches the invention substantially as claimed. Brenner teaches a screen containing the name of each of the wagering pools. (Fig 14) Brenner does not, however, teach displaying the tax status of each of the totes. Brenner teaches that the invention may handle paperwork required by tax and other regulations. (Col 19, 53-59) This means that the system would obviously have to have information on the tax status of each of the wagering pools. Tax considerations are often of the tremendous importance to

players when determining where to wager. Hirsimaki teaches that tax percentages (a portion of the mutuel take) are used to calculate the payout from any bet, thus they are a factor in determining the true odds. (Col 2, 55-59) It would have been obvious to one of ordinary skill in the art to modify Brenner in view of Hirsimaki to display the tax status on each of the pools in order to provide the player with important information to use in determining the true odds.

Claims 23, 64, 105 & 143: Brenner teaches the invention substantially as claimed. Fig 19 is a screen that displays information on the name of the pools. The odds associated with the wager and the pool value for the multiple pools. Brenner does not, however, teach displaying the tax status of each of the pools. Brenner teaches that the invention may handle paperwork required by tax and other regulations. (Col 19, 53-59) This means that the system would obviously have to have information on the tax status of each of the totes. Tax considerations are often of the tremendous importance to players when determining where to wager. Hirsimaki teaches that tax percentages (a portion of the mutuel take) are used to calculate the payout from any bet, thus they are a factor in determining the true odds. (Col 2, 55-59) It would have been obvious to one of ordinary skill in the art to modify Brenner in view of Hirsimaki to display the tax status on each of the pools in order to provide the player with important information to use in determining the true odds.

Claims 24, 26, 65, 67, 106, 108, 144 & 146: Brenner teaches the invention substantially as claimed. Brenner teaches automatically applying selection criteria so that certain users are "permitted to have access to certain racetracks

(and their associated totes), sets of races, wager types (i.e., wagering pools), or wager amounts." (Col 10, 56-61) Brenner teaches that the invention may handle paperwork required by tax and other regulations. (Col 19, 53-59) But Brenner does not explicitly teach using the tax status of a particular wagering pool as a selection criterion. Hirsimaki teaches that tax percentages (a portion of the mutuel take) are used to calculate the payout from any bet, thus they are a factor in determining the true odds. (Col 2, 55-59) The larger the tax, the smaller the payout and the worse the odds. It would have been obvious to one of ordinary skill in the art to modify Brenner in view of Hirsimaki automatically apply pool selection criteria based on the tax status on each of the pools in order to provide the player with a maximum payout.

Claims 25, 66, 107 & 145: Brenner teaches the invention substantially as claimed. Brenner teaches automatically applying selection criteria so that certain users are "permitted to have access to certain racetracks (and their associated totes), sets of races, wager types, or wager amounts." (Col 10, 56-61) Brenner teaches displaying the odds associated with a wager. (Fig 17) Brenner does not, however, teach automatically selecting the wagering pool that has the best odds for a particular wager. The odds determine the payoff to the player. Many (if not most) players want the payoff to be as high as possible. Hirsimaki teaches calculating the odds of each proposition in order to determine the highest available payout. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brenner in view of Hirsimaki to automatically

selected the wagering pool that has the best odds for a particular wager in order to maximize the payout to the player.

Claims 27, 68, 109 & 147: Brenner teaches the invention substantially as claimed. Brenner teaches automatically applying selection criteria so that certain users are "permitted to have access to certain racetracks (and their associated totes), sets of races, wager types (i.e., wagering pools), or wager amounts." (Col 10, 56-61) Brenner teaches displaying the pool value associated with a wager. (Fig 19) Brenner does not, however, teach automatically selecting the tote that has the highest pool value. Hirsimaki teaches that the pool value determines the payoff to the player. Many (if not most) players want the payoff to be as high as possible. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brenner in view of Hirsimaki to automatically selected the wagering pool that has the highest pool value for a particular wager in order to maximize the payout to the player.

Allowable Subject Matter

9.   Claims 28, 69, 120 & 158 are allowed.

10.   The following is an examiner's statement of reasons for allowance: The prior art fails to teach, either alone or in combination, automatically applying tote selection criteria that are based on bulk benefits associated with using each of the multiple totes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

11.   Applicant's arguments filed 6 May 2003 have been fully considered but they are not persuasive.

12.   Applicant's arguments are drawn to the claims as amended and are addressed above. Applicant should note that Brenner does teach multiple independent pools. The pools for win, place, and show are independent of each other.

Conclusion

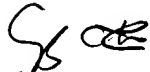13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	US Patent Number	Applicability
Mindes	5,573,244	Automated system multiple pools
Troy et al.	4,689,742	Automated betting system
Beachley	3,762,712	Horse racing game multiple pools
LaDue	5,999,808	Cell phones for betting
Lange	4,322,612	Automated horse race wagering system
Levy	3,810,627	Automated horse race wagering system
Scarne	N/A	Horse Racing Background

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 308-

1148.

cbc
July 23, 2003

JESSICA HARRISON
PRIMARY EXAMINER